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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLEN M. GILBERT, DAVID LOUIS KAMINSKY, and
BALACHANDAR RAJARAMAN

Appeal 2009-006032
Application 10/635,586¹
Technology Center 2400

Before JOSEPH L. DIXON, JAY P. LUCAS, and JOHN A. JEFFERY,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING²

¹ Application filed August 6, 2003. The real party in interest is International Business Machines Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants request a rehearing of the Decision mailed June 9, 2010, affirming the final rejection of claims 1 to 18.

Appellants' invention relates to a way of efficiently performing systems administration policy enforcement (Spec. 5, ¶ [0008]).

Representative claim 1 illustrates the claims on Rehearing:

1. A systems administration policy enforcement method comprising the steps of:

responsive to a request to perform an administrative task directed to a resource within a computing network, retrieving an administration policy comprising a set of rules for governing said administrative task, further retrieving state data for said resource and applying said retrieved policy to said retrieved state data; and,

permitting said administrative task only if said further retrieved state data satisfies said set of rules in said retrieved policy.

Appellants, in their Request for Rehearing, contend that the Board of Patent Appeals and Interferences (“Board”), in its analysis, impermissibly relied upon findings and conclusions not made by the Examiner. (Req. Reh’g. 6, ll. 1 to 2). More specifically, Appellants contend that “a decision of the BPAI is limited to the findings and conclusions made by the Examiner” with respect to claim construction of the claimed “administrative task,” as recited in claim 1 (*id.*) (emphasis omitted).

We disagree. Claim construction is a question of law which is reviewed *de novo*. *In re Donaldson Co.*, 16 F.3d 1189, 1192 (Fed. Cir. 1994) (en banc).

Claim construction at this Board involves *de novo* review and is one of the essential functions of this administrative law body. As a Board deciding disputes between Appellants and Examiners, we are not limited to the Examiner's findings and conclusions with respect to claim construction (*id.*). We are entitled to review and rely upon the entire record before us. The entire record before us includes the whole prosecution history of the patent application, including any and all of the references cited by the Examiner.

In this case, we thoroughly reviewed the Lortz reference cited by the Examiner in the course of prosecution for all that the patent teaches. (*See In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968) (holding that “[a]ll of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art.” The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” (quoting *In re Boe*, 355 F.2d 961, 965 (CCPA 1966))).

We weighed all of the teachings of Lortz against the claimed invention and, in doing so, adopted a claim construction with respect to the phrase “administrative task” (claim 1). Nowhere in the 15-page Request for Rehearing have Appellants rebutted our claim construction of the term “administrative task.” Rather, Appellants merely argue, without evidentiary proof, our interpretation of “administrative task” differs from its ordinary meaning in the art. (Req. Reh’g. 4, ll. 11 to 12; 6, ll. 23 to 24). While Appellants contend that “[the disclosure] is intrinsic evidence as to the meaning of the phrase ‘administrative task,’” they do not specify that particular meaning (*id.* at 4, ll. 11 to 12). That is, they merely state that there

is a difference but do not specify the difference. In fact, Appellants do not even cite a portion in the Specification from which this Board could deduce the difference between our interpretation and the ordinary meaning of “administrative task.” Appellants merely state: “[T]he Honorable Board cannot ignore that Appellants’ Specification is intrinsic evidence as to the meaning of the phrase ‘administrative task.’ [No citation given]” (*Id.*).

We find that there is no definition in the Specification³ that redefines “administrative task” so that the claim element can no longer be considered one type of access to a resource on a network, as disclosed in Lortz and Appellants have provided no citation thereof or other extrinsic evidence thereof. Further, we find that Appellants’ argument is unconvincing, as it provides no hint as to how or why our claim construction is unsubstantiated by a preponderance of the evidence before us. Indeed, our factual findings rest upon a “preponderance of the evidence” standard. (*See Ethicon, Inc. v. Quigg*, 849, F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).)

Next, Appellants contend that the Board impermissibly “converted” the rejection of claim 1 under 35 U.S.C. § 103(a) over Lortz in view of

³ *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-1313. (Fed. Cir. 2005) (en banc) (holding that “the words of a claim ‘are generally given their ordinary and customary meaning.’ ... [T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” (internal citations omitted))

Hopmann into a rejection of claim 1 under 35 U.S.C. § 102 based upon Lortz alone (Req. Reh.'g. 9, middle; 13, middle).

Again, we disagree. Appellants urge that the ultimate criterion of whether a rejection is considered “new” in a decision by the Board is whether Appellants have had fair opportunity to react to the thrust of the rejection. We agree with this general proposition, for otherwise Appellants could be deprived of the administrative due process rights established by 37 C.F.R. § 41.40(b) of the Patent and Trademark Office. *See In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). However, under the facts of this case, we neither impermissibly converted the obviousness rejection into an anticipation rejection nor added a new ground of rejection. The basis for the Examiner’s rejection remains 35 U.S.C. § 103(a) obviousness. The evidence considered by the Examiner to demonstrate obviousness included, principally, the Lortz and Hopmann patents. In affirming, the Board used the same basis but, without disagreeing with the Examiner’s approach, limited its discussion to the evidence contained in Lortz. *See id.* at 1303.

Finally, Appellants press their argument that the claimed “state data” must not be read upon Lortz’s “device policy” on the basis that “this finding is not supported by substantial evidence.” (Req. Reh’g. 14, ll. 12 to 14).

Again, we find unconvincing Appellants’ argument since this Board previously made claim construction findings that render the claimed “state data” obvious in view of Lortz’s “device policy.” (*See Ex parte Gilbert*, No. 2009-006032, slip op. at 10 to 11 (BPAI June 9, 2010); *see also* the claim construction discussion, *supra*.)

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Application 10/635,586

DECISION

The Request for Rehearing has been fully considered and is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING DENIED

llw/peb

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